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REMARKS

Claims 1, 14 and 16-26 are pending in the application. Claims 1, 14, and 16-24 were rejected by the Examiner in an Office Action dated 06/28/2005. Applicants have amended Claims 1, 14, 22 and 23, cancelled Claim 21, and added Claims 25 and 26, herewith. Reconsideration of the pending claims is respectfully requested.

Claim Rejection – 35 USC § 102:

A. The Examiner has rejected Claims 1, 14, and 16 under 35 USC 102(b) as being anticipated by Noguchi (US 5,184,261).

For a prior art reference to anticipate in terms of 35 U.S.C. 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Applicants will now show that every element of the claimed invention recited in Claim 1 is not identically shown by the cited Noguchi reference, and thus Claim 1 is not anticipated by such reference.

Claim 1 recites:

a robotic mechanism disposed between the left multitude of slots and the right multitude of slots, the robotic mechanism being operative to move the plurality of cartridges between the plurality of slots and the at least one media drive, wherein the robotic mechanism comprises (1) a picker assembly operative to insert and remove at least one storage media cartridge of the plurality of storage media cartridges from the left plurality of slots, the right plurality of slots, and the at least one media drive; (2) a first linear carriage operative to move the picker assembly along a first path approximately perpendicular to the back side of the housing; and (3) a second linear carriage operative to move the picker assembly from a position which allows access to at least one of the left multitude of slots to a position which allows access to at least one of the right multitude of slots.

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In rejecting Claim 1, the Examiner states that Noguchi teaches the claimed robotic mechanism by element 6 of Figure 12 (the so-called cassette conveyor). Applicants urge that the only description of such cassette conveyor is at Noguchi Col. 3, lines 31-36, where it states:

"The cassette conveyor 6 arranged between the two cabinets 4, 5 can move also in two dimensional directions, and convey selectively either of the cassettes of two kinds from any one of the shelves 3 to any one of the recording and/or reproducing apparatuses 7, or vice versa."

and at Noguchi Col. 6, lines 8-12, where it states:

"After passing through the cassette outlet 11, the cassette 2 is put on a convey belt (not shown) within the cassette conveyor 6, and at that time, the bar-code 14b of the small-sized cassette is automatically read by the bar-code reader 16."

That is the extent of Noguchi's description of cassette conveyor 6, which is alleged to read on the claimed 'robotic mechanism'. Applicants urge that a mere statement of two-directional movement, and an ability to convey cassettes to/from the shelves from/to the recording apparatus with a conveyor belt does not disclose the specific features recited in Claim 1 that pertain to the claimed 'robotic mechanism'. The claimed robotic mechanism comprises three distinct claimed sub-elements – (1) a picker assembly operative to insert and remove at least one storage media cartridge of the plurality of storage media cartridges from the left plurality of slots, the right plurality of slots, and the at least one media drive; (2) a first linear carriage operative to move the picker assembly along a first path approximately perpendicular to the back side of the housing; and (3) a second linear carriage operative to move the picker assembly from a position which allows access to at least one of the left multitude of slots to a position which allows access to at least one of the right multitude of slots. Perhaps a side-by-side comparison of the claimed features with the teachings of the cited reference will make this distinction apparent.

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Claim 1:Noguchi Teachings regarding element 6:

<p>(1) a picker assembly operative to insert and remove at least one storage media cartridge of the plurality of storage media cartridges from the left plurality of slots, the right plurality of slots, and the at least one media drive;</p> <p>(2) a first linear carriage operative to move the picker assembly along a first path approximately perpendicular to the back side of the housing; and</p> <p>(3) a second linear carriage operative to move the picker assembly from a position which allows access to at least one of the left multitude of slots to a position which allows access to at least one of the right multitude of slots.</p> <p>Perhaps a side-by-side comparison of the claimed features with the teachings of the cited reference will make this distinction apparent.</p>	<p>The cassette conveyor 6 arranged between the two cabinets 4, 5 can move also in two dimensional directions, and convey selectively either of the cassettes of two kinds from any one of the shelves 3 to any one of the recording and/or reproducing apparatuses 7, or vice versa (col. 3, lines 31-36).</p> <p>After passing through the cassette outlet 11, the cassette 2 is put on a convey belt (not shown) within the cassette conveyor 6, and at that time, the bar-code 14b of the small-sized cassette is automatically read by the bar-code reader 16 (col. 6, lines 8-12).</p>
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Applicants respectfully submit that these scant statements by Noguchi regarding functional capability of a cassette conveyor do not disclose every one of the three specific sub-features recited with respect to the claimed 'robotic mechanism', and thus Claim 1 is not anticipated by the cited reference (as every element of the claimed invention is not identically shown in a single reference).

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Applicants have also amended Claim 1 to recite that the left plurality of slots, right plurality of slots, media drive(s) and robotic mechanism (which includes the first linear carriage and the second linear carriage) all lie in a common plane, thereby advantageously providing a storage library having a reduced height such that it can be used as a standard rack-mounted device (Specification page 3, lines 20-24). It is thus urged that in addition to not being anticipated by the cited reference, amended Claim 1 is not obvious in view of the cited reference.

Applicants traverse the rejection of Claims 14 and 16 for similar reasons to those given above with respect to Claim 1.

Therefore, the rejection of Claims 1, 14 and 16 under 35 USC 102(b) has been overcome.

B. The Examiner has rejected Claims 21 and 22 under 35 USC 102(b) as being anticipated by Sato et al. (US 5,293,284). This rejection is respectfully traversed.

With respect to Claim 21, such claim is being cancelled herewith, without prejudice or disclaimer.

With respect to Claim 22, Applicants have merely amended such claim as to form, and not as to substance. Specifically, Claim 22 was dependent upon Claim 21, and is being amended herewith to be in independent form (to include all the features of Claim 21, which is thus being cancelled herewith). Therefore, Claim 22 is not being amended for purposes of patentability, but instead is being amended to be in independent form. Claim 22 recites a feature of "wherein the at least one media drive is at least two media drives, the storage library further comprising a rear linear carriage disposed between the at least two media drives and the housing, and operative to move the at least two media drives approximately parallel to the back side of the housing to align each media drive one at a time with the picker assembly". Applicants urge that the cited Sato reference does not teach (or otherwise suggest) this claimed feature, and thus it is urged that Claim 22 has been erroneously rejected by the Examiner as every element of the claimed invention is not identically shown in a single reference.

Therefore, the rejection of Claim 22 under 35 USC 102(b) has been overcome.

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Claim Rejection – 35 USC § 103

A. The Examiner has rejected Claims 17 – 20 under 35 USC 103(a) as being unpatentable over Noguchi (US 5,184,261) in view of Luffel et al. (US 6,222,699).

With respect to Claim 17, Applicants initially urge that the combination of Noguchi and Luffel fails to teach all of the claimed sub-features of the robotic mechanism, for reasons identified above with respect to Claim 1 (of which Claim 17 depends upon).

Still further with respect to Claim 17, Applicants urge that none of the cited references teach or suggest the claimed feature of “wherein the left and right plurality of slots and the plurality of storage media cartridges are oriented so that each label side of the plurality of storage media cartridges is visible to an operator through the opening, and *wherein each of the left and right plurality of slots are accessible to the operator via the opening for the operator to access the storage media cartridges being held by the left and right plurality of slots without complete entry of the operator into the storage library*”. None of Noguchi’s slots, except for cassette inlet 9 shown in Figure 12, are operator accessible. Luffel might possibly have a few slots immediately adjacent the door (although not shown in the Figure or described in the Specification) that are accessible without complete entry by an operator – but we cannot be sure because this is not disclosed. However, even if this were true, Luffel still doesn’t teach or otherwise suggest the claimed feature of “wherein each of the left and right plurality of slots are accessible to the operator via the opening for the operator to access the storage media cartridges being held by the left and right plurality of slots without complete entry of the operator into the storage library”. It is therefore submitted that a prima facie showing of obviousness

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has not been established by the Examiner¹, and thus the burden has not shifted to Applicants to rebut an obviousness assertion².

Still further with respect to Claim 17, Applicants urge that the references have been combined using improper hindsight analysis. As the Federal Circuit outlines in *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004), in making the assessment of differences between the prior art and the claimed subject matter, section 103 specifically requires consideration of the claimed invention "as a whole". Inventions typically are new combinations of existing principles or features. *Envtl. Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtuall all [inventions] are combinations of old elements"). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. *Ruiz*, 357 F.3d at 1275. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. *Id.* This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result – often the essence of invention. *Id.* Contrary to this reasoning, section 103 requires assessment of the invention as a whole. *Id.* This "as a whole" assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. *Id.* In other words, section 103 requires some suggestion or motivation, before the

¹ In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974).

² Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *In re Oetiker, supra*. If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

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invention itself, to make the new combination. *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, Federal Circuit, No. 04-1493, June 9, 2005. Applicants will now show why there would have been no suggestion or motivation to selectively combine the teachings of Noguchi with Luffell in accordance with the invention recited in Claim 17.

Noguchi is directed to a cassette autochanger that can mechanically accommodate different sized cassettes without user intervention. An access inlet is provided at 9 of Figure 12 to allow a user to insert or retrieve different sized cassettes from the autochanger. The user cannot access any cassettes other than the one being inserted or retrieved thru cassette inlet 9 (col. 3, lines 40-44). Nor is there any ability for a user to view any of the labels on any of the internal cassettes within the front cabinet 4 or rear cabinet 5. There would have been no reason or other motivation to provide operator accessibility to each or the slots, since if each of the slots were operator accessible, there would have been no reason to provide an automated technique for loading different sized cartridges into such slots – which is the expressed purpose of the Noguchi teachings. In effect, modifying Noguchi in accordance with the claimed invention would have eliminated the need for much, if not all, of the Noguchi teachings for automated cassette loading and unloading into the shelves. The only motivation for such modification must therefore be coming from Applicants' own patent specification/claims, which is improper hindsight analysis as described above. Thus, it is further urged that Claim 17 has been erroneously rejected using improper hindsight analysis.

The features of Claim 17 advantageously provide improved usability and accessibility by a user or operator of the storage library. First, the user may insert or remove storage media cartridges from the library through the opening. Maintenance on the robotic mechanism, media drive(s) and other internal components may be performed through the opening. Also, the user can view labels on the label side of the storage media cartridges by looking in through the opening (Specification page 8, lines 8-17).

Applicants traverse the rejection of Claim 18 for reasons given above with respect to Claim 17 (of which Claim 18 depends upon).

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Applicants traverse the rejection of Claim 19 (and dependent Claim 20) for similar reasons given above with respect to Claim 17.

Therefore, the rejection of Claims 17-20 under 35 USC 103(a) has been overcome.

B. The Examiner has rejected Claims 23 and 24 under 35 USC 103(a) as being unpatentable over Sato et al. in view of Luffel et al.

With respect to Claim 23 (and dependent Claim 24), Applicants urge that none of the cited references teach or suggest the claimed feature of "wherein the left and right plurality of slots and the plurality of storage media cartridges are oriented so that each label side of the plurality of storage media cartridges is visible to an operator through the opening, and *wherein each of the left and right plurality of slots are accessible to the operator via the opening for the operator to access the storage media cartridges being held by the left and right plurality of slots without complete entry of the operator into the storage library*" for similar reasons to those described above with respect to Claim 17.

Therefore, the rejection of Claims 23 and 24 under 35 USC 103(a) has been overcome.

NEWLY ADDED CLAIMS

Claims 25 and 26 have been added herewith, and support for such claims is found at least in Figure 6 and associated text within the present Specification. Examination of such claims is respectfully requested.

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CONCLUSION

It is respectfully submitted that all pending claims are allowable in view of the cited references. The Examiner is invited to contact the undersigned attorney if it is believed such contact would be useful in placing this case in condition for allowance.

Respectfully submitted,
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